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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,425	03/09/2001	Dean Rhoades	05309P001X	7222

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EXAMINER

CHOI, FRANK I

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 07/29/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Applicant's Name

09/802,425

Applicant(s)

RHOADES, DEAN

Examiner

Frank I Choi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/20/2002, 6/6/2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 7, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6. 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5,7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There does not appear to be any disclosure in the Specification which sets forth the average particle size being less than 125 microns. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement. See, e.g., *In re Lukach*, 169 USPQ 795 (CCPA 1971) (subgenus range was not supported by generic disclosure and specific example within the subgenus range); *In re Smith*, 173 USPQ 679, 683 (CCPA 1972) (a subgenus is not necessarily described by a genus encompassing it and a species upon which it reads).

#### *Claim Rejections - 35 USC § 102/103*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,5,7,21,22 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Messenger (US Pat. 6,290,976).

Messenger expressly discloses a composition comprising corundum powder having size of about 120 FEPA, mineral oil, moisturizer falling within the scope of applicant's claims (Claims 1-7).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Claims 1,2,21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lee et al. (US Pat. 6,294,179)

Lee et al. expressly discloses a composition comprising calcite having particles sizes falling within the claimed range of 50 to 556 microns, surfactants, hectorite, xanthan gum and water falling within the scope of Applicant's claims (Column 5, Column 6, lines 1-20).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same

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exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant's claim does not define what constitutes the moisturizer and Applicant's Specification appears to indicate that the moisturizer can contain a combination of substances (Paragraphs 0014,0015). The term "moisturizer" means a cosmetic lotion or cream applied to the skin to counter dryness. See *The American Heritage Dictionary of the English Language*, Fourth Edition (2000). The carrier in *Lee et al.* appears to fall within the scope of said definition as it is in the form of a cream or lotion and contains water and it is applied to the skin.

Therefore, the prior art composition appears to fall within the scope of the claimed invention.

Claims 1-3, 21,22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over *Saperstein* (US Pat. 3,092,111) or *Stiefel* (US Pat. 4,957,747).

*Saperstein* expressly discloses a composition comprising aluminum oxide having particles sizes falling within the claimed range of 50 to 556 microns, surface-active agent, emollient and water falling within the scope of Applicant's claims (Column 6, lines 36-75, Column 7, Columns 13-16, claims 11,12).

*Stiefel* expressly discloses a composition comprising aluminum oxide having particles sizes falling within the claimed range of 50 to 556 microns, emollients, soap formers and water falling within the scope of Applicant's claims (Column 2, Examples 1,2).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses products and uses that contain the same

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exact ingredients/components as that of the claimed invention. See *In re Fitzgerald*, 205 USPQ 594 (CCPA 1980). See also *In re May*, 197 USPQ 601, 607 (CCPA 1978).

Examiner had duly considered Applicant's arguments but deems unpersuasive for the same reasons as above. Further, the Specification specifically discloses that the moisturizer can include humectants, glycerin, propylene glycol, lanolin, and silicone derivatives. The Saperstein composition contains lanolin, polyethylene glycol, glycerine and water (Column 7, lines 6-10). The Stiefel reference includes polyethylene glycol, dimethicone, glycerine and water (Column 2, lines 15-65). Therefore, the prior art compositions fall within the claimed inventions.

Claims 1-3,5,7,21,22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Imamura et al. (US Pat. 4,284,533).

Imamura et al. teach a composition containing abrasives, such as aluminum oxide and magnesium oxide, wherein the particle size of the abrasive can range from 2 to 150 microns and larger, surfactants, hydrotropes, polyacrylic acid (Column 1, lines 65-68, Column 2, Column 3, lines 36-45).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose using abrasive particles in the range of 50 microns to 556 microns or 125 microns or less. However, the prior art amply suggests the same as it is known to use abrasive particles overlapping said range. As such, it would have been well within the skill of an one of ordinary skill in the art would have been motivated to modify the prior art as above depending on the desired abrasiveness of the composition.

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Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been taught by the teachings of the cited reference.

Examiner has duly considered Applicant's arguments but deem them unpersuasive for the same reasons as above. Further, the Specification specifically discloses that the moisturizer can include humectants and propylene glycol. Imamura et al. discloses the use of glycols and glycol ethers. As such, the prior art teaches the use of substances which appear to meet the definition of "moisturizer" set forth in the Specification. With respect to the limitation "cream", the term "cream" is not defined by the Specification. As such, the fact that the reference teaches a viscosity of less than 5000 cps does not appear to teach away from the claimed invention.

Claims 5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (US 20002/0090385).

Fox et al. discloses a portable, inexpensive, easy to use microdermabrasion composition containing aluminum oxide having particles sizes of about 40 microns or about 100 microns in a cream carrier which holds the aluminum oxide crystals and can contain Vitamin C, Vitamin E and moisturizers as desired to be used in the cosmetic (Paragraphs 0005,0012,0013, 0024,0025,0026,0027,0028, Claims 1-7).

The difference between the prior art and the claimed invention is that the prior art does not expressly disclose a composition in the form of a cream having corundum suspended in the base with an average particle size of less than 125 microns. However, the prior art amply suggests the same as the prior art discloses the incorporation of aluminum oxide crystals in a cream and particles sizes of about 40 and about 100 microns and additionally adding other

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substances such as Vitamin C, Vitamin E and moisturizers. As such, the claimed invention would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that the cream carrier would hold the aluminum oxide crystals, that other substances which are known to be used in cosmetics, such as vitamins and moisturizers, could be added as desired, that the composition would be portable, inexpensive and easy to use, and that the size of the particles could be varied depending on the desired abrasiveness of the composition.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been taught by the teachings of the cited reference.

### ***Double Patenting***

Applicant indicates that it is holding in abeyance the response to the provisional double patenting rejection, as such, Examiner maintains the provisional double patenting rejection of claims 1-3,5,7,21,22 over claims 1-3,6-12 of copending Application No.09/411,712 in view of Lee et al. (US Pat. 6,294,179), Saperstein (US Pat. 3,092,111), Stiefel (US Pat. 4,957,747) OR Imamura et al. (US Pat. 4,284,533) for the reasons of record set forth in the prior Office Action.

### ***Conclusion***

Applicant's amendment and information disclosure statement necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Thurman Page, can be reached on (703) 308-2927. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC

July 24, 2003



JOHN PAK  
PRIMARY EXAMINER  
GROUP 1600